

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

19378.0011

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed
Name _____

Application Number
09/857,606

Filed
August 2, 2001

First Named Inventor
M. Dahlbäck

Art Unit
1742

Examiner
H. Wilkins, III

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

**The review is requested for the reason(s) stated on the attached sheet(s). Note:
No more than five (5) pages may be provided.**

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- ☒ attorney or agent of record.
Registration number 47,252
- ☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Signature

Sean P. O'Hanlon

Typed or printed name

(202) 295-8429

Telephone number

September 21, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.



"Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



APPLICANTS' REMARKS IN SUPPORT OF THE
PRE-APPEAL BRIEF REQUEST FOR REVIEW

Claims 13, 22, 23, and 35-40 are pending in the application. The Examiner rejected claims 13, 22, and 23 under 35 U.S.C. § 112 as failing to comply with the written description requirement. The Examiner rejected claims 13, 22, 23, and 35-37 under 35 U.S.C. § 102 as being clearly anticipated by U.S. Patent No. 5,023,048 to Mardon *et al.* (Mardon) as supported by U.S. Patent Nos. 5,790,623 to Van Swam (Van Swam) and 5,254,308 to Garde *et al.* (Garde '308). The Examiner rejected claims 38-40 under 35 U.S.C. § 103 as being unpatentable over Mardon modified by U.S. Patent No. 5,211,774 to Garde *et al.* (Garde '774)

The Written Description Rejections of the Claims

The Examiner rejected claims 13, 22, and 23, alleging that the claims contain subject matter that was not adequately described in the specification. Specifically, the Examiner stated that "[t]he specification only provides support for the range of O being 500-1600 ppm." *See* the June 21, 2005 final Office Action at section 2.

The specification, however, supports the recited range of up to 1600 ppm oxygen. Page 9 of the written description at lines 20-21 specifically states that "small amounts of Si and O *may* exist in the alloy" (emphasis added). While an expected range of oxygen is enumerated at the bottom of page 9 of the written description, one of skill in the art would recognize, from the entirety of the disclosure, that the inventive alloy may include up to 1600 ppm oxygen. Thus, this recitation is supported by the application as filed. This matter was fully addressed in the Applicant's last Response. *See* the May 31, 2005 Response to Office Action at pages 5-6.

The Anticipation Rejections of the Claims

The Applicants amended independent claim 13 and added independent claims 35 and 38 in the last Response. *See* the May 31, 2005 Response to Office Action at pages 2-4. Each of these independent claims recites a cladding tube made of a certain element. *Id.* Mardon, however, discloses a duplex tube with an inner main component that is made of a standard alloy that is completely different than the alloy of the present invention.. The Applicants fully explained the differences between the cladding tube according to the present invention and the duplex tube of Mardon in the last Response. *See* the May 31, 2005 Response to Office Action at pages 7-8. The Examiner, however, erroneously interprets the two types of tubes to be the same. *See* the June 21, 2005 final Office Action at sections 4 and 8.b. For this reason, the Examiner's rejections are improper and must be withdrawn.

Furthermore, Mardon appears to disclose a thin outer protective layer having a composition given in examples 1-3 in column 3. Only example 2 provides a composition that arguably is similar to the Applicants'. As previously explained, example 2 teaches lower tin and niobium content than in the Applicants' alloy. *See* the May 31, 2005 Response to Office Action at pages 8-9. Also as previously explained, there is no indication in Mardon that a person skilled in the art would choose exactly the upper limit (0.65) for tin and at the same time select the very highest upper limit for the niobium content (0.65). *Id.* at page 9. Thus, Mardon does not suggest the alloy defined in the instant independent claims. On the contrary, the alloy according to Mardon example 2 appears to teach away from the alloy defined in the instant independent claims, since Mardon teaches a lower range for the tin content and a lower range for the niobium content. Moreover, Mardon does not even suggest such an alloy for the main portion of the tubular element.

Furthermore, regarding claims 22 and 36, the claims require a inner circumference of the cladding tube be provided with a material that is more ductile than the alloy, rather than being less ductile as stated by the Examiner. The rejections of these claims are further improper for this additional reason.

Furthermore, regarding claims 23 and 37, the Examiner did not address the recitations of these claims in the final Office Action. The rejections of these claims are further improper for this additional reason.

The Obviousness Rejections of the Claims

The comments provided above regarding claims 13, 22, 23, and 35-37 apply equally to claims 38-40. The obviousness-type rejections of claims 38-40 are improper for at least the same reasons, and must therefore also be withdrawn.

Other Cited Art

The impropriety of the Examiner's reliance upon Van Swam, Garde '308, and Garde '774 is fully addressed in the Applicant's last Response. *See* the May 31, 2005 Response to Office Action at pages 10-11.

Conclusion

While no fee is believed due in conjunction with these Remarks or the underlying Request, the Commissioner is hereby reauthorized to charge any insufficiency or credit any overpayment associated with this application to Swidler Berlin LLP Deposit Account No. 19-5127 (order no. 19378.0011). The Applicant respectfully requests reconsideration and issuance of a Notice of Allowance for all claims. Should the Examiner or a member of the reviewing

Panel feel further communication would help prosecution, such Examiner is urged to call the undersigned at the telephone number provided below.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "Sean P. O'Hanlon", with a stylized, cursive flourish at the end.

Sean P. O'Hanlon
Reg. No. 47,252

Dated: September 21, 2005

Swidler Berlin LLP
3000 K Street, NW
Suite 300
Washington, DC 20007
(202) 295-8429